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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,191	02/18/2000	Paul England	MS1-408US	8393
22801	7590	05/23/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,191

Applicant(s)

ENGLAND, PAUL

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43 and 45-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43 and 45-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/17/2006 has been entered.

Response to Arguments

2. In response to communications filed on 3/17/2006, no claims have been currently amended, the following pending claims 43 and 45-62 are presented for examination.

2.1 Applicant's remarks, pages 7-13, filed on 10/18/2005, have been considered but they are not persuasive. With respect to claim 43, applicant argues that the Office's stated motivation that of improving efficiency is too general and lacking particularity that is required when making a prima facie case of obviousness. Examiner respectfully disagrees. Applicant's consideration of the suggestion and motivation of the previous office action is in error because applicant is not addressing the whole suggestion/motivation provided in the office action. There is clearly suggestion and motivation provided in the previous office action and supported by citation, which states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Ansell et al.** to randomly retrieving data as taught by **Herzberg et al.** in order to more efficiently validate the multimedia program because the

random selection helps reduce the possibility of forgery as the checking may be based on part or all of the data (see **Herzberg et al**, claims 9 and 27; column 6, lines 18-34 and column 6, lines 35-46)". As mentioned above, one of ordinary skill in the art would have been motivated to modify Ansell by utilizing random selection because when checking portion of data as in Ansell, the validation is more exposed to forgery, and by using random selection of portion of data to be verified against unauthorized use, it efficiently provides a validation with reduced forgery; "random" is knowledge generally available to one of ordinary skill in the art and defined as being unpredictable. In other terms, a random selection of data for validation renders the validation unpredictable. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some suggestion provided in the references themselves as provided on page 5 of the last Office Action. Ansell discloses selecting portions of data to be validated by encryption or digests. Herzberg teaches that it is desirable to have an element of randomness in the selection process for unpredictability of the data to be validated to reduce forgery and make the data unpredictable (see column 8, lines 10-17 and column 10, lines 4-21). The following (Herzberg, column 6, lines 18-34) is an abstract of the citation provided in the teaching and suggestion of Herzberg in the last Office Action.

"Typically, a multimedia title takes about one hour to play and contains about 650 megabytes of data. As a result, it is inefficient to validate a multimedia title by reading and

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checking each byte within the title. In accordance with a preferred embodiment of the present invention, the multimedia title is validated by checking a portion of the data contained therein.

Random sampling of data to validate multimedia titles is employed in accordance with a preferred embodiment of the present invention. If the data locations to be sampled were constant from one instance of validation to the next, then only a small portion of the multimedia title would be checked. In such a situation, forged titles could be more easily constructed. But by randomly selecting data locations for sampling, the possibility of forged multimedia titles is greatly reduced.

In addition, the presently claimed invention utilizes data context sampling. A significant improvement in the validation of multimedia titles may be achieved if the logical structure of the multimedia titles themselves is employed to identify key pieces of data to be validated. For example, a preferred checking strategy may be based on checking part or all of the data in the table of contents for each file in a multimedia title. A multimedia title consists of one or more files, each containing its own table of contents. In many cases the multimedia title contains only one such file. When a file is opened, the table of contents is the first item to be read".

As indicated above, Herzberg teaches the advantage of checking only a selected portion of the data to be validated rather than checking all of the data (in order to minimize the required processing time column 12, lines 26-32); checking a small portion of data could be exposed to forgery, thus the invention as taught by Herzberg provides a degree of randomness: "by randomly selecting the portion of data to be validated, the possibility of forgery can be greatly reduced". In view of the above, Applicant has not overcome the rejection; therefore, it remains the Examiner's position that claims 43 and 45-62 are still rejected in view of Ansell and Herzberg.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1 **Claims 43, and 45-62** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,367,019 to **Ansell et al.** in view of US Patent 5,745,678 to **Herzberg et al.**.

3.2 **As per claims 43, 46, 49-50, 57-58, Ansell et al.** substantially discloses a method comprising: receiving a request to access a given content (column 2, lines 52-67 and column 13, line 60 through column 14, line 12); “retrieving plurality of blocks of data including at least serial number and keys from storage medium” (*column 8, lines 18-43*) that meets the recitation of retrieving plurality of blocks of data from a storage medium; and discloses retrieving different sets of data from different fields that meets the recitation of wherein at least one block of data includes data not contained in a given content (*column 8, lines 18-67*) for more detailed disclosure of representation of data file where at least one block of data includes data not contained in a given content (see also application 09/020025 or US patent 6,868,403 which is a continuation of application 09/020025 disclosed by Ansell as incorporated by reference, see Ansell, column 5, lines 1-18); generating a digest value for each of the plurality of randomly retrieved blocks of data (column 7, lines 48-64 and column 8, lines 45-58); and further discloses “comparing digest value to a set of verification data” (*column 8, lines 45-57 and column 7, lines 50-67*), and also discloses “determining that the computer-readable media contains an original version of the given content if the digest values match a subset of the verification data” (*column*

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8, lines 45-67 and column 6, lines 20-29). As interpreted by Examiner, **Ansell et al** discloses allowing access to a smaller number of times of playback which is a smaller functionally equivalent version than the original version (column 11, lines 26-38) and discloses allowing access to an encrypted compression version which is smaller than the original based on the matching of digests values to a subset of verification data that meets the recitation of allowing access of a functionally equivalent version of the given content which is smaller than the original version (see column 8, lines 45-67; column 21, lines 52-57; see also column 5, lines 1-18); access to a compressed version which is smaller than the original such as an MP3 format is very well known in the art as disclosed in the background of **Ansell et al** (column 1, lines 12-20) the invention can also be used to acquire music products from the Internet (column 13, lines 60 through column 14, line 12). **Ansell et al.** is silent about the word randomly when teaches retrieving data. However, **Herzberg et al.** in an analogous art teaches randomly retrieving data to determine if data is valid, the random selection helps reduce the possibility of forgery, and **Herzberg et al.** further discloses authenticating randomly retrieved data for validity by comparing calculated hash values with stored ones to see if they are equal, then a determination is made that an original version of a program is either authorized or not based on the matching, for example (see column 15, lines 15-21; column 17, lines 15-30; column 5, line 58 through column 6, line 46 and column 6, lines 61-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of retrieving portion of data to be validated for execution of **Ansell et al.** to randomly retrieving selecting portion of data as taught by **Herzberg et al.** in order to more efficiently validate the multimedia program because the random selection helps reduce the possibility of forgery as the checking

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may be based on part of the data (see **Herzberg et al**, claims 9 and 27; column 6, lines 18-34 and column 6, lines 35-46). This modification would have been obvious because one of an ordinary skill in the art would have been motivated by the suggestion provided above by **Herzberg et al**. so as to more efficiently validate the multimedia program to reduce the possibility of forgery, the motivation to do so is provided by Herzberg who teaches the advantage of checking only a selected portion of the data to be validated rather than checking all of the data (*see column 6, lines 18-34*) in order to minimize the required processing time, column 12, lines 26-32. As indicated above, checking a small portion of data could be exposed to forgery thus the invention as taught by Herzberg provides a degree of randomness, “by randomly selecting the portion of data to be validated, the possibility of forgery can be greatly reduced” (see column 6, lines 18-34).

As per claims 45 and 59, the combination of **Ansell et al.** and **Herzberg et al** discloses allowing access to related material if the digest values match a subset of the verification data (*see Ansell et al*, column 8, lines 45-67; column 21, lines 52-57; see also column 5, lines 1-18).

As per claim 47, the combination of **Ansell et al.** and **Herzberg et al** discloses **Herzberg et al.** discloses wherein the processes of randomly retrieving a plurality of blocks of data, generating digest values, comparing each of the digest values and determining that the computer-readable media contains an original version are performed, when a validation structure that indicates that the material is protected that meets the recitation of watermark is embedded in the functionally equivalent version of the given content (**Herzberg et al**, column 1, lines 50-67),

(see also **Ansell et al**, column 6, lines 38-50 column 1, lines 60-64, and see also application 09/020025 or US patent 6,868,403 which is a continuation of application 09/020025 disclosed by Ansell as incorporated by reference, see Ansell, column 5, lines 1-18). Therefore claim 47 is rejected on the same rationale as the rejection of claim 43.

As per claim 48, Herzberg et al. discloses further comprising: partitioning a trusted version of the first content into a plurality of verification data blocks; and establishing the plurality of verification data by calculating a cryptographic hash value for each of the plurality of verification data blocks (column 6, lines 18-46 and column 7, lines 35-55 and column 8, lines 40-67). Therefore claim 48 is rejected on the same rationale as the rejection of claim 43.

As per claim 51, Ansell et al. discloses controlling access based on specific type of data that can be played that meets the recitation of wherein controlling access to a functionally equivalent version of a given content comprises playing a requested music file if the calculated digests value match a subset of the associated verification digest values (column 11, lines 10-38).

As per claims 52-53, the combination of Ansell et al. and Herzberg et al discloses restriction imposed on specific data as a condition for downloading and playback that meets the recitation of wherein controlling access to a functionally equivalent version of a given content comprises launching a requested application program if the calculated digests value match a subset of the associated verification digest values, **Herzberg et al** discloses restriction imposed on specific data as a condition for downloading and playback when access is allowed it is

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inherent that a program has to be launched for playback (column 11, lines 10-38 and column 8, lines 45-67) and preventing installation of a requested music file if any of the calculated digest values do not match any associated digest value (column 12, lines 56-67 and column 11, lines 45-67) and the use of digest value is disclosed in (column 7, lines 50-63 and further in column 8). **Herzberg et al** also discloses the limitations of this claim (see **Herzberg et al**, claims 1-3). Therefore claims 52-53 are rejected on the same rationale as the rejection of claim 43.

As per claim 54, Herzberg et al. discloses wherein the set of associated verification digest values are stored with the original version of the given content (column 10, lines 38-58). Claim 54 is rejected on the same rationale as the rejection of claim 43.

As per claim 55, Ansell et al. discloses the use of Internet to obtain verification data from dedicated server that meets the recitation of wherein the set of associated verification digest values are available on an internet web site (column 14, lines 1-12).

As per claim 56, Ansell et al. discloses verifying that the set of associated verification digest values come from a known authority (column 2, lines 52-67).

As per claim 59, Ansell et al. discloses wherein the verification module is further adapted to control access to related material if the calculated digest values match a subset of the known valid digest values

As per claims 60-62, the combined references discloses that the invention can be performed with an audio player coupled to a computer system through the Internet comprising processors that meets the recitation of data reading device and further discloses a handheld audio player containing a functionally equivalent version of the given content (see **Ansell et al**, figure 1 and column 4, line 62 through column 5, line 18) and verification module located in a handheld audio player (see **Ansell et al**, figure 5).

Conclusion

4. This is a continuation of applicant's earlier Application No. 09/507,191. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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4.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Carl Colin

Patent Examiner

May 17, 2006



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